

Hearing:
October 9, 2001

6/11/02

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper Nos. 39 & 32
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MBNA American Bank, N.A.

Serial Nos. 74/417,538 and 74/472,908

Michael R. Grow of Arent Fox Kintner Plotkin & Kahn, PLLC for
MBNA American Bank, N.A.

Jeffery C. Coward, Examining Attorney, Law Office 106 (Mary I.
Sparrow, Managing Attorney).

Before Cissel, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

On July 27, 1993, applicant filed an application to
register on the Principal Register the service mark MONTANA
SERIES for services, as amended, recited as "credit card
services featuring credit cards depicting scenes or subject
matter of, or relating to, the state of Montana,"¹ in
International Class 36, based upon an allegation of
applicant's *bona fide* intention to use the mark in interstate

¹ The amendment to allege use for the MONTANA SERIES application
was filed on May 11, 1994, claiming use in commerce as of July 1993,
with specimens showing use of the mark on the front of an MBNA
MasterCard.

commerce.² Then on December 9, 1993, applicant filed an application to register on the Principal Register the service mark PHILADELPHIA CARD for services, as amended, recited as "credit card services featuring credit cards depicting scenes or subject matter of, or relating to the city of Philadelphia" (with the word CARD disclaimed apart from the mark as shown) in International Class 36, based upon applicant's allegation of its *bona fide* intention to use the mark in interstate commerce.³ This application continues as an intent-to-use application.

² Applicant's earlier-filed application, DELAWARE SERIES, matured into Reg. No. 1,743,542, issuing on December 29, 1992, (with Sections 8 & 15 affidavits having been accepted and acknowledged respectively), and applicant's companion application, KENTUCKY SERIES, matured into Reg. No. 1,928,952, issuing on October 24, 1995. Still pending, awaiting the outcome of the MONTANA SERIES appeal, are applications for the following STATE NAMES immediately preceding the word SERIES: ALABAMA, ARKANSAS, ARIZONA, COLORADO, CONNECTICUT, FLORIDA, GEORGIA, HAWAII, IDAHO, ILLINOIS, INDIANA, IOWA, KANSAS, LOUISIANA, MASSACHUSETTS, MICHIGAN, MISSISSIPPI, MISSOURI, NEBRASKA, NEVADA, NEW HAMPSHIRE, NEW JERSEY, NEW MEXICO, NEW YORK, NORTH DAKOTA, MAINE, MARYLAND, MINNESOTA, NORTH CAROLINA, OHIO, OKLAHOMA, OREGON, PENNSYLVANIA, RHODE ISLAND, SOUTH CAROLINA, SOUTH DAKOTA, TENNESSEE, TEXAS, UTAH, VERMONT, VIRGINIA, WEST VIRGINIA, WASHINGTON and WISCONSIN, as well as one having a REGION NAME preceding the word SERIES: NEW ENGLAND SERIES. All of these applications involve service marks for credit card services.

³ Applicant's companion application, THE NEW ENGLAND WATERS CARD, matured into Reg. No. 1,939,038, issuing on November 28, 1995. Still pending, awaiting the outcome of the PHILADELPHIA CARD appeal, are applications for the following CITY NAMES immediately preceding the word CARD: ATLANTIC CITY, BALTIMORE, BOISE, CINCINNATI, CLEVELAND, COLUMBUS, DENVER, DES MOINES, DETROIT, INDIANAPOLIS, KANSAS CITY, LAS VEGAS, LITTLE ROCK, LOUISVILLE, MEMPHIS, MINNEAPOLIS, NEW ORLEANS, NEW YORK, OMAHA, PITTSBURGH, PORTLAND, ST. LOUIS, SAN DIEGO, SAN FRANCISCO, SEATTLE, and THE WASHINGTON DC CARD, as well as a card carrying one of Chicago's nick-names (WINDY CITY CARD) and geographical locations followed by the words "HERITAGE CARD," such as PORTSMOUTH HERITAGE CARD and CAPE COD

The currently assigned Trademark Examining Attorney has made final the Office's refusal to registration in both applications under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the marks MONTANA SERIES and PHILADELPHIA CARD, when applied to the recited services of applicant, are merely descriptive of them.

The prosecution of these two applications has been protracted as each application has been handled by a series of Trademark Examining Attorneys, the grounds for refusal have been changed several times, and each application has been the subject of an earlier remand from the Board for further consideration by the Trademark Examining Attorney. Although the record in each of these cases is voluminous, much of each record is directed toward statutory grounds that have since been withdrawn.⁴

Applicant has appealed. Both applicant and the Trademark Examining Attorney have fully briefed these consolidated cases, and at applicant's request, an oral hearing was held before the Board.

We affirm the refusals to register.

HERITAGE CARD. All of these applications involve service marks for credit card services.

⁴ These withdrawn grounds included at various times potential citations against the marks for likelihood of confusion, as well as issues involving the geographically descriptive and geographically misdescriptive provisions of the Lanham Act.

I. Affinity Credit Cards

Applicant, MBNA America Bank ("MBNA"), is the world's largest independent credit card issuer, with special emphasis on its Gold MasterCard product. It has also pioneered "affinity" marketing -- usually a partnership between a bankcard issuer and a non-profit, social or lifestyle association.⁵ MBNA understands that people are proud of their voluntary associations, whether it be professional or educational organizations, special causes, sports organizations, or in the instant case, regional affiliations. In its successful fight for consumers' wallets, applicant aims for their hearts with credit cards that make these emotional connections with consumers. Many of these affinity card arrangements also provide financial rewards to the group or association. For example, each time that the consumer uses her MBNA AMERICA MADD MasterCard credit card, the bank will automatically donate a portion of each retail transaction to Mothers Against Drunk Driving (MADD) for its advocacy programs. Given the attendant benefits for such

⁵ "MBNA brings Branch Here," Atlanta Business Chronicle, December 2, 1991; "MBNA's New Cards take cardholders down highways and byways," Credit Card News, December 15, 1992; "Affinity King MBNA American Bank is taking cardholders on a figurative tour of the Midwest with its latest affinity card entry," Cardfax, December 7, 1992.

organizations, applicant has the endorsement of more than five thousand such entities.⁶

Going well beyond sports teams, universities, wine connoisseurs, bird lovers, national associations, Star Trek fans, or Harley Davidson motorcycle enthusiasts, applicant has also initiated a line of affinity cards named after the fifty states, large metropolitan areas,⁷ geographical regions of the country, historic districts and even several prominent watersheds within the United States. Although the Trademark Examining Attorney has submitted evidence that, at least with applicant's earlier Delaware Series MasterCard program, applicant promised to make financial contributions to its home state tied to each transaction,⁸ there is no indication in this

⁶ Throughout these files, along with the literature in the record detailing the operation of various affinity cards, the record shows that applicant also promotes "co-branded" cards - resulting from a partnership between a bankcard issuer and a commercial partner. The cardholders using co-branded cards may get prizes, freebies or discounts on co-branded products for earning points by charging purchases on the card. Co-branding makes use of the brand strength of both partners, and is based on the logic that if a customer is loyal to one brand, he/she will want to purchase the other. Additionally, each co-branded partner gets access to a database of customers of a similar demographic profile.

⁷ "MNBA pushes city pride credit cards," Bank Letter, April 12, 1993.

⁸ "Now, to honor Delaware and the people who live here, MBNA has created an exclusive credit card program to benefit our home state - and yours. And in recognition of Delawareans' strong community spirit, these cards offer you a unique opportunity to help your neighbors at no additional cost. MBNA will make a contribution to the Delaware Community Foundation every time you use your Delaware Series MasterCard or Gold MasterCard to make a purchase..." MBNA flyer attached to Office Action of November 22, 1994.

record that entities in Montana or Philadelphia, for example, will be similarly designated.

II. Summarizing the positions of applicant and the Trademark Examining Attorney

The Trademark Examining Attorney contends that the marks MONTANA SERIES and PHILADELPHIA CARD merely describe "the most notable and visible feature of the applicant's credit card services, that is, the credit card itself." (Trademark Examining Attorney's appeal brief, p. 5).⁹ He points to the latest, detailed recitations of services, which specifically indicate that the trade dress of each of the cards depicts a

⁹ The service marks at issue do appear in each case to describe in some way the trade dress of the corresponding credit card. In support of his position that this is critical, the Trademark Examining Attorney points to the case where the Southern District of New York found "GOLD CARD" to be generic for credit card services based upon the fact that the card itself was gold in color. See American Express Co. v. MasterCard International Inc., 685 F.Supp. 75, 7 USPQ2d 1829 (S.D.N.Y. 1988). Applicant distinguishes this case by pointing out that the Court found that American Express, MasterCard and many of their competitors "used the color gold to indicate a premium level of financial credit that was available to a select group of customers" (Applicant's reply brief, p. 3), and that, therefore, the term referred to much more than just the background color of the credit card itself. In a later decision giving preclusive effect to the Court's earlier judgment, this Board appeared to recognize the fact that "gold card" represented more than simply the color of the card itself (e.g., premium level of credit available to a selected customers). See MasterCard International, Inc. v. American Express Co., 14 USPQ2d 1551 (TTAB 1990). Furthermore, we note from the current records, consistent with applicant's contentions, that the credit terms, payment options, etc., for any individually-named card product or collection of card products seem to be in no way tied to the differing themes of the regional affinity cards issued by applicant. Accordingly, we do not find American Express Co. v. MasterCard International, *supra*, to be dispositive of the question before us.

scene relating to the place named. The Trademark Examining Attorney argues that in light of applicant's adoption of these particular regional designations and its subsequent marketing programs, the regional labels aptly describe a significant feature of the trade dress of the respective credit cards, and that hence, they should be deemed descriptive of the underlying credit card services.

In his briefs and at oral argument, the Trademark Examining Attorney placed a great deal of emphasis on the manner in which applicant's regional affinity marketing program is structured. The Trademark Examining Attorney argued that applicant is unabashed in the way it entices consumers to sign up for its cards by adopting trade dress on the front of the credit card that is designed to appeal to an individual, regional affiliation with which consumers might want publicly to identify. The Trademark Examining Attorney argued that regional ambiance -- i.e., the scenes depicted on the promotional materials and then integrated into the trade dress of the credit cards as issued -- is a primary reason for the consumer's selection of a particular card. Then, each time the consumer uses the credit card for a financial transaction, the use of the card again brings all of these regional images to mind.

Applicant appears to agree with the Trademark Examining Attorney's position on the following point: the combination of the background designs and the corresponding service marks making up the trade dress on the credit cards will often be the motivating factor for the consumer in choosing a specific credit card service. However, while the Trademark Examining Attorney contends that we must consider applicant's marketing strategies as they relate to the ultimate consumer's desire to use a particular card, applicant argues that the reason why a particular targeted consumer chooses the MONTANA SERIES credit card services is totally irrelevant to our determination herein of mere descriptiveness.

Moreover, applicant argues that the Trademark Examining Attorney has confused its credit card services with the "advertising materials, credit cards, and/or other materials on which Applicant's mark may be displayed." (applicant's reply brief, p. 1). Applicant argues that there is no support in the record or in trademark law for the contention of the Trademark Examining Attorney that the details of its affinity marketing program, combined with the display of scenes from Montana on the front of the credit card itself, render the mark MONTANA SERIES merely descriptive for the associated credit card services. In this vein, applicant argues strenuously that even if one decides that these marks may be

merely descriptive of the designs on the cards, these marks are not merely descriptive of the underlying credit card services.

Finally, applicant argues that the record is devoid of any direct evidence that consumers view MONTANA SERIES or PHILADELPHIA CARD as being merely descriptive of credit card services. Rather, applicant argues that in applying the precedents of this Board and our principal reviewing court, we cannot conclude that these marks will immediately convey to consumers pertinent information regarding any significant characteristic or feature of applicant's credit card services. Accordingly, as we turn to discuss the test for descriptiveness, we note our agreement with applicant and with the Trademark Examining Attorney on this critical question: how do (or how will) prospective customers perceive these asserted marks?

III. The Continuum of Distinctiveness

The test for determining whether a mark is merely descriptive is whether the mark immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used.

See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215

(CCPA 1978); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). Accordingly, this case reflects sharp disagreement between applicant and the Office about where on the spectrum of distinctiveness these marks should be placed.¹⁰

Applicant has taken the position throughout the prosecution of these applications that members of the public are likely to associate immediately a unique source with the specific geographical themes that applicant has chosen.¹¹ In fact, applicant goes so far as to contend that these terms, while admittedly containing geographical terms, are "wholly arbitrary" and, hence, inherently distinctive as applied to its credit card services - analogizing repeatedly to the mark APPLE for computers. Without question, APPLE for computers is an arbitrary designation. However, as noted below, we find applicant's analogy to APPLE computers to be unpersuasive, and of little assistance in reaching our determination herein.

¹⁰ As has often been noted by our principal reviewing court, placement of a term on the fanciful/arbitrary-suggestive-descriptive-generic continuum is a question of fact. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

¹¹ At first blush, one might well conclude that these place names, appearing as they do with non-proprietary images of well-known landmarks on the trade dress of credit cards, would not be seen as inherently distinctive service marks. One might analogize to the ornamentation of T-shirts, where pictures, insignia, slogans or even place names may be emblazoned across the front of the shirt. See In re Astro-Gods Inc., 223 USPQ 621 (TTAB 1984). Similarly, in the context of these credit cards, some may question whether these regional designations are actually being used as service marks. However, because that issue is not before us, we decline any further pursuit of this question.

IV. Determining what is "merely descriptive"

By contrast with the adoption and use of the term APPLE as applied to computers, the record in the instant case shows that the affinity labels applicant has adopted herein are clearly *not* arbitrary. Each of the marks sought to be registered identifies the region where the majority of prospective users will likely reside, and each affinity mark describes rather precisely the respective trade dress of that named card or series of cards.

If a given source identifier is inherently distinctive (e.g., APPLE for computers), the basic objective underlying trademark law is the immediate protection of that merchant's or manufacturer's trade identity and the protection of the public from confusion created by those who would encroach upon a unique identity that the public is coming to associate with another. In registering such a term, the Office creates no disadvantage for competitors, as others clearly do not need to use an inherently distinctive term adopted by a competitor. An arbitrary designation is valuable because as an informational device, it boldly announces where the service originates (or answers the buyer's question "who are you?"). However, immediately upon adoption, it is an empty vessel in terms of its ability to convey information about the services.

On the other end of the spectrum of distinctiveness, a generic designation answers the question "what are you?" and should remain freely available to all competitors in any given field to refer to their products or services. In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed Cir. 1999) [THE BEST BEER IN AMERICA for beer and ale]. Continuing our analogy, a generic term is a vessel chock full of information about a characteristic or feature of the services.

In between these contrasting results, the nuances of merely descriptive matter require a balancing of informational advantage and competitive disadvantage that comports with how the public perceives and uses these designations over time, and in a manner that is totally consistent with accepted business practices in a particular industry or market sector.

Lest it be forgotten, descriptive terms are regarded as words in the "public domain" in that competitors should be free to use these terms to describe their own brands of the same products or services. See Minnesota Mining and Manufacturing Co. v. Johnson and Johnson, 454 F.2d 1179, 172 USPQ 491 (CCPA 1972). In such cases, accordingly, one enterprise cannot, by mere adoption, obtain an exclusive right to prevent others from using the same descriptive term. Such exclusive appropriation by a single party unfairly inhibits competition by others in the involved industry.

In the instant case, each regional designation is packed with informational content prior to its adoption as a source-indicator. Unlike the word APPLE arbitrarily applied to computers, MONTANA SERIES or PHILADELPHIA CARD is *not* an empty vessel upon adoption for affinity credit card services - it begins as a partially full vessel. Granted, before applicant uses these designations as service marks in connection with credit card services, these regional labels belong to an amorphous community of interest, not being tied to any particular source. However, upon adopting MONTANA SERIES (or PHILADELPHIA CARD), applicant is attempting to tap into the preexisting value of regional designations, transforming a congenial public symbol to its own informational advantage. At the precise moment that an applicant adopts this type of term for its credit card services, however, a regional designation cannot logically be associated with one entrepreneur.¹² Rather, black letter trademark law stands for the proposition that rights in such terms should only be recognized with respect to a user who has created acquired distinctiveness through consumer recognition of the terms.¹³

¹² Provided this is correct, it is hard to understand applicant's contention that members of the public will associate immediately a unique source (namely MBNA) with the specific geographical themes that applicant has chosen.

¹³ While we find in this decision that MONTANA SERIES, for example, readily informs a prospective purchaser as to a significant feature of the corresponding affinity credit card service, we also

In the present case, applicant has not pursued registration under Section 2(f) of the Act, but rather claims that the marks are inherently distinctive.

We focus, as we must in making a determination under Section 2(e)(1), on applicant's recitals of services in these two applications. Each recital herein makes it clear that applicant's services feature credit cards "depicting scenes of subject matter of, or relating to, the state of Montana (or city of Philadelphia)." Thus, MONTANA (or PHILADELPHIA) immediately conveys information about the community of intended users to whom these particular services are directed.¹⁴ All of its regional designations, such as MONTANA SERIES or PHILADELPHIA CARD, are displayed prominently on applicant's promotional materials. Accordingly, we find that even if the credit card itself had only the name MONTANA SERIES (i.e., absent the graphic trade dress), this term would still be merely descriptive of these credit card services.

However, consistent with industry practices as it relates to affinity and co-branded credit cards, the trade dress

have no doubt but that after a period of substantially exclusive and continuous use by MBNA America, the prospective consumer who becomes a long-term debtor/card holder will come to understand that this designation does indeed identify a service provided by a single source.

¹⁴ See *In re Hunter Publishing*, 204 USPQ 957 (TTAB 1979) (JOBBER AND WAREHOUSE EXECUTIVE); and *In re Camel Manufacturing Co.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER).

stands as strong reinforcement of the respective regional themes. That is, the trade dress of the actual credit card contains scenes of Montana (or Philadelphia). Hence, inasmuch as MONTANA SERIES identifies the community of intended users of these particular services, as well as the ambiance of the trade dress of the plastic credit card itself, we conclude that MONTANA SERIES describes a significant feature or characteristic of these affinity credit card services.

We find unpersuasive the distinction that applicant tries to make between its marketing program, advertising materials, and the trade dress of its credit card, on the one hand, and the underlying credit card services offered under the corresponding regional label, on the other hand.

After all, applicant's services involved herein are essentially "regional affinity" credit card services. The appeal to regional pride and loyalties is a most significant feature of the way in which applicant markets the relevant credit card services. A potential purchaser living on a ranch outside Missoula may desire a credit card issued by MBNA that is emblazoned with the term MONTANA SERIES and accompanying images of Montana precisely because of his affinity for the state of Montana. On the other hand, unless the resident of Philadelphia is into mountain climbing, skiing or fly-fishing, she is more likely to choose the PHILADELPHIA CARD. In our

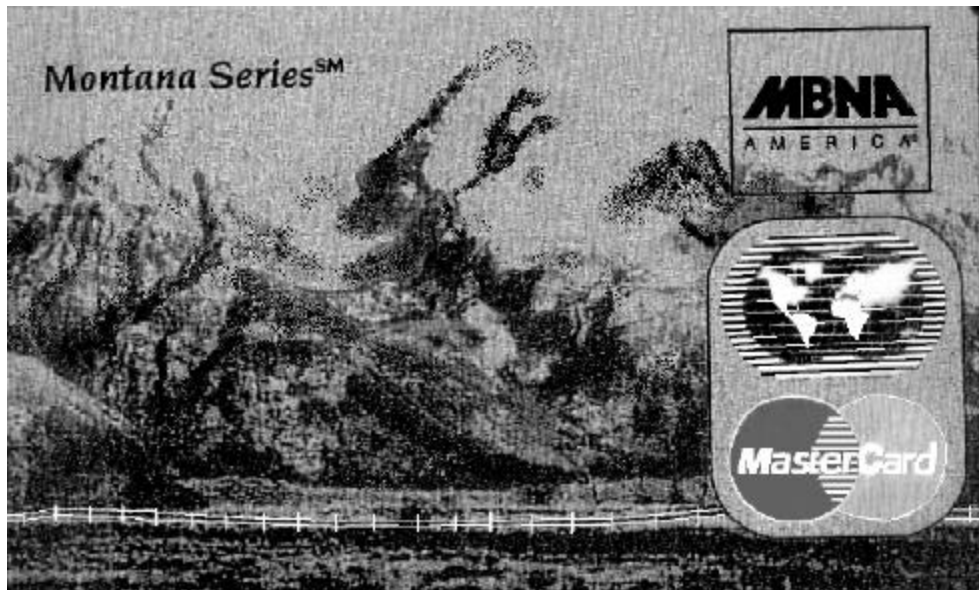
hypothetical, irrespective of which card proves to be commercially successful by producing the stronger affinity (i.e., which one "motivates" her to become a card holder),¹⁵ each designation immediately and forthwith conveys information as to a significant feature or characteristic of that particular credit card service.

As the Trademark Examining Attorney points out, applicant's entire marketing program is based upon the fact that applicant is taking advantage of the value of regional affinities, and that this association or alliance is a primary reason for the consumer's selection of a particular card. Then, what could be a more apt way to inform a consumer about the regional association than the exact geographical designation? And what better way to reinforce this association than having the trade dress on the credit card itself bearing public icons of the place named?

These regional designations are used, or are intended to be used, in solicitations and advertisements to prospective credit card customers. After the card is issued, the credit card is the most prominent and enduring physical embodiment of applicant's services. The regional designation is used fairly prominently on the trade dress of the card as issued to the card holder/debtor. For example, the credit card specimens

¹⁵ See "purchaser motivation" discussion *infra* at pp. 18 to 21.

filed with the amendment to allege use in the MONTANA SERIES application depict a stereotypical Montana scene having grasslands in the foreground, a fence stretching across the middle of the picture, with an imposing Grand Teton-like mountain peak in the background that fades into the big sky of the American West:



Moreover, it appears from the record, that the regional designation would be used fairly prominently in some form on a monthly billing statement. The involved terms are used in a manner that is descriptive of a desirable and significant feature of the credit card. Hence, it is not a leap to find that these respective terms also describe a significant feature of the underlying credit card services (i.e., the cachet associated with a particular type of card by which the user gets entree to a variety of services). To the extent

that the phrase "MONTANA SERIES" plainly describes a group of credit cards bearing images from the state of Montana, this term also merely describes a significant feature of applicant's associated services.

In order for us to find that these service marks do indeed immediately convey information concerning a significant feature or characteristic of applicant's regional affinity credit card services, it is certainly not necessary that it describe *all* of its features or characteristics.¹⁶ In a recent Board decision, the term EGYPT was found to be merely descriptive as applied to amusement park services based upon public perceptions of the service mark, even though some aspects of the services (e.g., the foods and the souvenirs) had nothing to do with the country of Egypt. See In re Busch Entertainment Corp., 60 USPQ2d 1130 (TTAB 2001).

V. Clarifying "purchaser motivation"

In its brief and again at the oral hearing, applicant criticized the Trademark Examining Attorney for basing his argument on the fact that a customer wanting to identify with a regional designation may seek out a particular card.

¹⁶ In fact, as noted earlier (footnote 9) and again in the dissent, the credit terms, payment options, etc., for any individually-named card product or collection of card products seem to be in no way tied to the differing themes of the regional affinity cards issued by applicant.

Applicant contends that this line of argument is inappropriate because it relies upon a discredited theory of "purchaser motivation." However, we consider applicant's allegation of the Office's unwarranted reliance on "purchaser motivation" to be a straw man that applicant itself has erected. The Trademark Examining Attorney's discussion of applicant's regional affinity-marketing programs should not be confused with prohibited "purchaser motivation" in finding a term to be generic (e.g., failing to protect the valuable property rights of the owner of the MONOPOLY trademark because large groups of consumers merely wanted to play the familiar real estate board game).

Refusing registration merely because an aspect of the goods or services is "an important ingredient in the commercial success of the product" would be at odds with legal precedent,¹⁷ including that of our primary reviewing court. See In re Penthouse International Ltd., 565 F.2d 679, 682-83, 195 USPQ 698, 700-01 (CCPA 1977). In an oft-quoted concurring decision, the late Judge Nies warned that we must avoid " ... an esoteric and extraneous inquiry focusing on what motivates the purchasing public to buy particular goods... ." See In re DC

¹⁷ See Ives Laboratories v. Darby Drug Co., 601 F.2d 631, 643, 202 USPQ 548, 557 (2nd Cir. 1979) (quoting Pagliero v. Wallace China Co., 198 F.2d 339, 343, 95 USPQ 45, 48 (9th Cir. 1962)); Truck Equipment Service Co. v. Fruehauf Corp., 536 F.2d 1210, 1217-18, 191 USPQ 79, 85-86 (8th Cir. 1976), cert. denied, 429 U.S. 861.

Comics, Inc., 689 F.2d 1042, 215 USPQ 394, 404 (CCPA 1982), J. Nies, concurring [Drawings of Superman, Batman, and Joker as trademarks for toy dolls].¹⁸

In discussing purchaser motivation during oral arguments, applicant cited to the amendment to the Lanham Act in the wake of the Ninth Circuit's often derided Anti-Monopoly decision.¹⁹

¹⁸ In re DC Comics, Inc., J. Nies, concurring, *supra*, at 404-405: " ... The reason the public is motivated to buy the product, whether because of quality, particular features, source, pleasing design, association with other goods, price, durability, taste, or prestige of ownership, is of concern to market researchers but is legally immaterial to the issue of whether a particular designation is generic. Thus, the board's reliance on its conclusion that purchasers want appellant's dolls 'and would simply not be satisfied' with any others is misplaced. This rationale ignores the reality that the primary objective of purchasers is to obtain particular goods, not to seek out particular sources or producers, as such. Motivation does not change a descriptive term which has acquired distinctiveness or any arbitrary word, name, symbol or device into a generic designation. The correct inquiry is whether the public no longer associates what was a trademark with that single source.

Similarly, that purchasers call for a particular product by the name given it by its producer or source does not negate its function as a mark. Such a given name is a proper name, like the name of an individual, not a generic name, so long as the public uses it to identify a product of a single source. It is the normal way the public uses a mark which is applied by a manufacturer or a merchant to a particular product, and, as indicated, trademark concepts do not require the condemnation of normal commercial language. Trademark law merely condemns the use of that language in a way which deprives purchasers of their expectations and deprives businesses of the goodwill which they have built up by providing satisfactory goods and services. For the same reason, that a trademark is well known does not make it a "common" descriptive name. "Common," like "generic," states a conclusion that the claimed mark is, or has become, part of the vernacular, that it is indefinite, and does not function as a proper name of a particular producer's goods ..."

¹⁹ See Anti-Monopoly Inc. v. General Mills Fun Group Inc., 684 F.2d 1326, 216 USPQ 588 (9th Cir. 1982), cert. denied, 103 S.Ct. 1234

However, on this entire record, we do not believe that the Office has premised its refusal to register on the theory of purchaser motivation.²⁰ Hence, we find ourselves in agreement with applicant that purchaser motivation, as that concept was employed in Anti-Monopoly and Section 14 of the Lanham Act, as amended,²¹ plays no part in the test herein for mere descriptiveness.

Decision: Having found that these respective terms do indeed describe significant characteristics or features of the recited credit card services, the refusals to register are affirmed.

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(1983) [MONOPOLY for popular real estate board game was held generic as no special test was applicable to "unique" goods situations, and consumer motivation of product over source (as measured by surveys) was critical, rather than overall consumer understanding].

²⁰ However, even if that were the gravamen of the Trademark Examining Attorney's argument, it would be misdirected in the instant case, as Section 14 of the Trademark Act applies only to registered marks, and the focus there is on matter that is allegedly generic (not merely descriptive).

²¹ See Section 14(3) of The Trademark Act of 1946 as Amended, 15 U.S.C. §1064(3), Nov. 8, 1984, 98 Stat. 3335]:

" ... A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used."

Cissel, Administrative Trademark Judge:

I respectfully dissent.

The majority states that "[t]he involved terms are used in a manner that is descriptive of a desirable and significant feature of the credit card," and that "[h]ence, it is not a leap to find that these respective terms also describe a significant feature of the underlying credit card services (i.e., the cachet associated with a particular type of card by which the user gets entrée to a variety of services.)"

Although I would not characterize the majority's finding as a "leap" (and I am not sure what "cachet" has to do with any of this), from my perspective, getting from the conclusion that these terms are merely descriptive of the scenes depicted on the credit cards to the holding that the terms are merely descriptive of the financial services rendered by means of the cards requires a step which is neither logical nor justified under the Lanham Act or the case law interpreting it. In the same sense, I cannot agree with the majority that the terms "MONTANA SERIES" and "PHILADELPHIA CARD," by themselves, notwithstanding the fact that they name the places pictured on the cards, describe applicant's financial services just because they name places for which prospective customers of applicant's services have affinity.

As noted by the majority (and as applicant concedes), the service marks in issue in each case do appear to describe the trade dress of the credit cards. In support of his argument that this is a critical fact, the Examining Attorney points to the case where "GOLD CARD" was held to be generic for credit card services based upon the fact that the card itself was gold in color. See American Express Co. v. MasterCard International Inc., 685 F.Supp. 75, 70 USPQ2d 1829 (S.D.N.Y. 1988). Applicant distinguishes this case by pointing out that the court found that American Express, MasterCard and many of their competitors "used the color gold to indicate a premium level of financial credit that was available to a select group of customers," (applicant's reply brief, p. 3), and that because of this fact, the term indicated much more than just the color of the credit card itself. In a later decision giving preclusive effect to the court's earlier judgment, the Trademark Trial and Appeal Board recognized the fact that the term "gold card" identified more than simply the color of the card itself; it signified the premium level of credit available to a selected group of customers. See MasterCard International, Inc. v. American Express Co., 14 USPQ2d 1551 (TTAB 1990).

In this connection, we note from the records in the instant appeals that, consistent with applicant's contentions,

the credit terms, payment options, and so forth for any of applicant's individually-named credit card services do not appear to be in any way tied to the differing themes presented on applicant's affinity cards, so the decision on the registrability of the mark "GOLD CARD" is not analogous.

In conclusion, I note that to the extent that we were to have any doubt as to whether applicant's marks are merely descriptive of the services specified in these applications, such doubt would necessarily be resolved in favor of the applicant. In re Bliss & Laughlin Industries, Inc., 198 USPQ 128 (TTAB 1978). Upon publication of applicant's marks, any entity that believes it would be damaged by the registration of these marks would have the opportunity to oppose registration. See In re Merrill Lynch, Pierce, Fenner and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

In summary, contrary to my colleagues, I cannot conclude that because the marks here sought to be registered describe features or characteristics of the particular cards on which they are used (or are intended to be used), these marks are also merely descriptive of the services set forth in the applications. In a similar sense, I cannot conclude that because "[e]ach of the marks sought to be registered

identifies the region where the majority of prospective users will likely reside," it "immediately conveys information about the community of intended users to whom these particular services are directed." I find no basis in these records for speculation regarding the likely residency of prospective users of cards bearing either of these two designations.

Moreover, when we determine the registrability of these marks in view of the established legal authority regarding Section 2(e)(1) of the Lanham Act, making the connection between naming a place and picturing it on a credit card, on the one hand, and concluding that the name is merely descriptive of the financial services with which the card is used, on the other hand, requires far too complex a thought process to be characterized as "immediate and forthwith."

In short, these marks may describe the cards, but they do not describe the services. Neither "MONTANA SERIES" nor "PHILADELPHIA CARD" immediately and forthwith conveys information about a significant characteristic or feature of credit card services. For this reason, I would reverse the refusal to register under Section 2(e)(1) of the Lanham Act.